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EXAMINER

THEIN, MARIA TERESA T

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDERICK L. ROSS

Appeal 2009-000417
Application 09/865,470
Technology Center 3600

Decided:¹ July 13, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-39 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellant's claimed invention is directed to managing the return of items purchased by a consumer from a remote merchandiser. The consumer takes the item to a local returns center who communicates the request to a returns manager. The returns manager provides a return validation code to the local returns site which is matched with a code provided by the consumer. (Specification 4:1-5 and 4:17-23). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method of using a public communications network to manage the return of an item purchased by a consumer from a remote direct merchandiser, comprising the steps of:
 - receiving a first communication at a returns manager system, the first communication comprising return request data from a local returns site;
 - providing a second communication from the returns manager system to the local returns site, the second communication comprising

return validation data having at least a return validation code;
validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site, the pre-authorization code obtained by the consumer and indicating prior approval of the return by a remote direct merchandiser from whom the item was purchased; and
crediting an account of the consumer for a return value of the returned item after validating the return;
wherein the first and second communications are communicated using a public communications network.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Junger	US 6,085,172	Jul. 4, 2000
Hauser et al	US 6,536,659 B1	Mar. 25, 2003

The following rejections are before us for review:

1. Claims 1-39 are rejected under 35 U.S.C. § 103(a) as unpatentable over Junger in view of Hauser.

THE ISSUES

At issue is whether the Appellant has shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 1-28 this issue turns on whether Junger and Hauser disclose “validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site”.

With regards to claims 29-39 this issue turns on whether Junger and Hauser disclose the limitation to “send a second communication to the retailer identifying the item of merchandise to be returned by the consumer to provide the retailer with advance notification of the return.”

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence²:

FF1. Junger discloses a method for handling product return transactions (Title).

FF2. Junger discloses that a product return center location obtains identifying information for a product to be returned. A return approval computer system receives this information and determines whether the returned product satisfies applicable return criteria. The return approval location may provide a list of approved and unapproved returns along with a return authorization number for a batch of approved items (Col. 2:41-56).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF3. Junger in Fig. 4H does not show the Batch # and RA number to be matching.

FF4. Junger does not disclose “validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site.”

FF5. Hauser discloses a method of facilitating returns of merchandise purchased from other sources (Title).

FF6. Hauser discloses that when a customer makes a purchase authorization for a return there is automatically provided a prepaid shipping label with a return authorization bar code which may be used to ship it to a National Return Center (Col. 7:66-Col. 8:10).

FF7. Hauser does not disclose any matching of the return authorization bar code provided by the consumer with a return validation code.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3)

the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16.

ANALYSIS

Claims 1-28

The Appellant argues the rejection of claim 1 is improper because the references fail to disclose or suggest “validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site” (Br. 21, Reply Br. 2).

The Examiner has determined that the Junger and Hauser combination does disclose “validating the return by matching the return validation code with a pre-authorization code.” The Examiner has found that Junger discloses a matching of an RA number and a return authorization number in Col. 2, lines 41-56. The Examiner has also found that Hauser discloses a pre-authorization obtained by the consumer prior to the approval of the return (Ans. 16).

We agree with the Appellant. Junger discloses that a product return center location obtains identifying information for a product to be returned (FF2). The return approval location may provide a list of approved and unapproved returns along with a return authorization number for a batch or approved items (FF2). Junger in Fig. 4H does not show the Batch # and RA number to be matching (FF3). Junger simply does not disclose “validating the return by *matching* the return validation code with a pre-authorization code provided by the consumer to the local returns site” (FF4) since no such matching is disclosed. Hauser does disclose the use of a conventional prepaid shipping label with a return authorization bar code which may be used for returns (FF6). However Hauser does not disclose any *matching* of the return authorization bar code provided by the consumer with a return validation code (FF7) as required in claim 1. For these reasons, the rejection of claim 1 and dependent claims 2-10 is not sustained. Claim 11 contains limitations similar to claim 1 and the rejection of this claim as well as dependent claims 12-20 is not sustained for these same reasons.

The Appellant has presented essentially the same arguments for claim 21 as for claim 1. Junger discloses that the return approval computer system determines whether the returned product satisfies applicable return criteria (FF2) and this serves as “return guideline” as required in claim 21. Regardless, Claim 21 does not include a limitation requiring “validating the return by *matching* the return validation code with a pre-authorization code provided by the consumer to the local returns site” which is the sole argument presented by the Appellant. For these reasons the rejection of

claim 21 is sustained. The Appellant has not argued for claims 22-28 separately and the rejection of these claims is accordingly sustained as well.

Claims 29-39

The Appellant argues the rejection of claim 29 is improper because the references fail to disclose or suggest “send[ing] a second communication to the retailer identifying the item of merchandise to be returned by the consumer to provide the retailer with advance notification of the return” (Br. 27-28, Reply Br. 5-6).

The Examiner has determined that Hauser discloses the above referenced limitation in teaching that a merchant can pre-authorize customers to return merchandise with which they are dissatisfied without the need to obtain further authorization (Ans. 18-19).

We agree with the Appellant. The cited claim limitation requires sending a second communication to the retailer to provide the retailer with advance notification of the return. The cited passage in Hauser cited by the Examiner (Col. 7:67-Col. 8:5) only discloses that the retailer automatically provides a customer with a prepaid shipping label with a return authorization bar code for return of the item (FF6). There is no disclosure in Hauser of a second notification to the retailer to provide them advance notification of the return as the claim requires. For these reasons, the rejection of claim 29 is not sustained. The rejection of dependent claims 30-39 is not sustained for these same reasons.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-20 and 29-39 under 35 U.S.C. § 103(a) as unpatentable over Junger in view of Hauser.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 21-28 under 35 U.S.C. § 103(a) as unpatentable over Junger in view of Hauser.

DECISION

The Examiner's rejection of claims 1-20 and 29-39 is reversed. The Examiner's rejection of claims 21-28 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

MP

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